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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/301,749    04/29/99    POWELL

K    104.012

EXAMINER
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TM02/0424

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ART UNIT	PAPER NUMBER

2165  
DATE MAILED:

04/24/01

*8*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*File*

# Office Action Summary

Application No.  
09/301,749

Applicant(s)  
Powell et al.

Examiner  
Cuong H. Nguyen

Art Unit  
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 19, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) 1-18, 25, 27, and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 26, 28-40, and 42-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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#### DETAILED ACTION

1. This Office Action is the answer to the communication received on 1/19/2001 (the Power of Attorney 's paper).
2. Claims **1-46** are pending in this application; claims 1-18, 25, 27, and 41 were canceled.

#### *Drawings*

3. This application has been filed with informal drawings, and they are required to be corrected as indications by the draftsman.
4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

#### *Specification Objection*

5. Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should

describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. The submitted abstract is objected for above reason.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

***The specification shall conclude with claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.***

A. Claim 19, 29, 43 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Evidence that claims 29, 43 fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about "a computer system configuration and method for processing discount information in a retail store.", and this

statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter's limitations in the bodies of those claims (a limitation of the claim only counts if it is disclosed in the body of a claim).

B. Claims **19, 35** are also indefinite with claims' last paragraph containing "...the with third signals read...".

C. A limitation of claim **29** said "to correlate the second signals with third signals from the card memory..." the examiner submits that such card memory is a passive device, it does not have an "active" signal (as called "third signal"). The term for "third signal" is not correctly used herein.

D. Claim **32** said "...wherein the signal path carries product identification information". This is always a fact; because a medium is always used to transmit a signal (a natural phenomenon), therefore, claiming signal path as a limitation is a non-statutory subject matter. Claim 29 is rejected with a similar rationale.

7. Claim **43** is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim recites limitations of "...executing ... a second program ... to correlate second signals with third signals ... " there are insufficient antecedent basis for this limitation in claim (because said "third signal" is undefined, and therefore, indefinite).

8. Claim 35 contains unclear/vague limitation (e.g. in line 4, it says "and for generating second signals" so that it can not be said the limitations are happening sequentially or simultaneously (e.g. generating 1<sup>st</sup> signal, and generating 2<sup>nd</sup> signal, in this way it is assumed that simultaneous steps are performed). The word "for" in this limitation is confused. The word "with" in the sentence "the with third signals read in the respective one of the cash register stations" does not have any meaning. Moreover, the plurality form of "generating first signals", "generating second signals", "reading third signals", are confused because preceding terms "first", "second", and "third", and the order of these signals.

9. Claims 19, 29, 35, 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

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failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application).

Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application).

10. Claims 20-24, 26, 28, 30-34, 36-40, 42, 44-46 are rejected under 35 U.S.C. 112, 2nd para. because they are dependent on their parent claims. In general, independent claims, have to be amended in order to improve claims's format to comply with US Patent laws.

A. In a broad reasonable interpretation, all the claims direct to a way of communicating between a computer and a scanning device. Therein, delivered messages are responded correspondingly to the predetermined content from computer devices.

B. Claim 43 is the most complex/sophisticated claim; it covers all limitations of independent claims (19, 29, and 35) although claims's language is different). Therefore,

the rationale for rejection of claim 43 are obviously applied for above-mentioned independent claims.

C. The examiner recognized that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references.

D. In re **Nomiya**, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Simon**, 174 USPQ 114 (CCPA 1972); In re **McLaughlin**, 170 USPQ 209 (CCPA 1971).

#### ***Conclusion***

11. All pending claims are rejected.

12. These references are considered pertinent to applicant's disclosure.

- Sugiyama et al., (US Pat.5,670,716 - filing date is 10/04/1995, patent date: 9/02/1999; US Class. 705/26), about a home terminal and shopping system (see the summary of the invention).

- Valencia et al., (US Pat.5,380,991 - filing date is 11/16/1993, patent date: 1/10/1995; US Class. 705/14),



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about a paperless coupon redemption system and method thereof (see the summary of the invention).

- Mueller et al., (US Pat. 5,353,219 - filing date is 6/10/1993, patent date: 10/04/1994; US Class. 705/16), about a suggestive selling in a customer self-ordering system (see the summary of the invention).

- O'Hagan et al. (US Pat. 5,821,513), disclose a shopping cart mounted portable data collection device - filing date is 11/05/1996) (see the summary of the invention).

13. Notes: The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with **claims' language**. In re **Mraz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), it says: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

A. In re **Van Geuns**, 26 USPQ2d 1057 (CA FC 1993), the court rules: Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

B. In re **Prater**, 162 USPQ 541 (CCPA 1969), the court rules: During patent examination, the pending claims must be given the broadest reasonable interpretation

consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

C. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961), the court rules: "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."

Note About Treatment of Combined References

D. *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981), the court rules: "One cannot show nonobviousness

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by attacking references individually where rejections are based on combinations of references."

E. In re **Merck & Co., Inc.**, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

F. In re **Nievelt**, 179 USPQ 224 (CCPA 1973), the court rules: "Combining teachings of references does not involve an ability to combine their specific structures."

G. In re **Bozek**, 163 USPQ 545 (CCPA 1969), the court rules: "Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

H. In re **Keller, Terry, and Davies**, 208 USPQ 871 (CCPA 1981), the court rules: "It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

I. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

J. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ), *the court rules*: "**The name of the game is the claim.**"

K. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See **Giles Sutherland Rich**, *Extend of Protection and Interpretation of Claims -- American Perspectives*, 21 Int'l Rev. Indus.

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Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

14. A. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Kuderna**, 165 USPQ 575 (CCPA 1970).

B. *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987)  
Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703)308-1065.

**Any response to this action should be mailed to:**

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Amendments

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

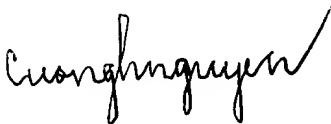
**or faxed to:**

(703) 308-9051 (for formal communications intended  
for entry)

**Or:** (703) 305-0040 (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the  
status of this application should be directed to the  
Group receptionist whose telephone number is (703) 305-  
3900.



Cuong H. Nguyen  
Patent Examiner  
April 19, 2001